

Office Action Summary

Application No.

10/524,517

Applicant(s)

MORIMOTO ET AL.

Examiner

Erich A. Leeser

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 8-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 11-21-08
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's correspondence dated November 5, 2008.
Claims 1 and 8-24 are pending and under examination.

Claim Rejections - 35 USC § 112

Examiner previously rejected claims 9 and 15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

- (a) Based on Applicant's argument and the specification as originally filed, Examiner withdraws this rejection.
- (b) Based on Applicant's claim amendment, Examiner withdraws this rejection.

Claim Rejections 35 U.S.C. § 103

Examiner previously rejected claims 1, 3, 5-6, 19-21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Wu, et al., U.S. Patent Publication 2003/208074.

This rejection is now moot with regards to claims 3 and 5-6 based on Applicant's cancellation of claims 3 and 5-6.

Upon further consideration, Examiner has concluded that Applicant has in fact overcome Wu, et al. based on Applicant's argument and Examiner erroneously concluding that the water content of the organic solvent was 15.8% instead of 29.6%.

Examiner previously rejected claims 1 and 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Kim, et al., *N-Benzoyloxycarbonyl-2-methylaminothiazoline as a Selective Benzoyloxycarbonylating Reagent of Amines*, Bull. Korean Chem. Soc., Vol. 24, No. 2, 157-58 (2003).

This rejection is now moot based on Applicant's cancellation of claims 3-6. However, Examiner maintains this rejection with regards to claim 1.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 19-24 are rejected under 35 USC 102(e) as being anticipated by Wu, et al., US 2005/0171120. Wu, et al. teaches stereoselective alkylation of chiral 2-menthyl-4-protected piperazines, which include instant processes and compositions. Specifically, the scheme showing the preparation of product X in column 3 of the reference anticipates the aforementioned processes where G is either alkoxy which overlaps with instant tert-butyl group, or aryloxy which overlaps with instant benzyl group.

Unlike Wu, et al., U.S. Patent Publication 2003/208074 where the water content of the organic solvent is easily determinable, Examiner is going to leave it up to Applicant to show that the reference does not read on the limitation of claim 1, "an organic solvent with a water content of 15 wt% or less" or the limitation of claim 21, "2% by HPLC area or less".

Claim Objections

Claims 8-18 are objected to as being dependent upon rejected independent claim 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you

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would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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